

Atty. Dkt. No. 035451-0143 (3673.Palm)

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. Because this response is being submitted within (2) months of the mailing date of the Office Action, a prompt Advisory Action is requested in the event that this reply is not found to place the present application in condition for allowance.

Claims 1-22 remain pending in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each claim.

**Claim Rejections – 35 U.S.C. § 103(a)****a. Rejection of claims 17-22 based on Ludwig et al. in view of Wilska et al.**

In section 3 of the Office Action, claims 17-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ludwig et al. (U.S. Patent No. 6,583,806) in view of Wilska et al. (U.S. Published Patent Application No. 2002/0082043). Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 17 for at least two reasons. First, the cited combination of Ludwig et al. in view of Wilska et al. fails to teach, disclose, or suggest all of the elements of claim 17 as combined therein. Second, there is no suggestion or motivation to modify Ludwig et al. or to otherwise combine the teachings of Ludwig et al. and Wilska et al. to arrive at the subject matter of claim 17.

As to the first reason cited above, claim 17 recites “a user selectable option that is configured to effectuate movement of at least one of the first indicator and the second indicator from their respective first or second screen portion to the other of the first and second screen portion.” The cited combination of Ludwig et al. in view of Wilska et al. does not teach, disclose, or suggest “a user selectable option that is configured to effectuate movement of at least one of the first indicator and the second indicator from their respective first or second screen portion to the other of the first and second screen portion” as included in the combination of

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elements of claim 17. What is taught in Ludwig et al. is that a display screen may show multiple participants of a conference call and may also show which of those participants are on hold. What is not disclosed by Ludwig et al. is that the display screen has two portions, for example an active portion and a hold portion, and the call indicators may be moved from one screen portion to the other screen portion and thereby effectuating the change in the call status. What is taught in Ludwig et al. is changing the hold status of call participants displayed on the screen such that the "mosaic" area and the "calls on hold" area are not mutually exclusive areas between which indicators are moved for effectuating changes in the call status. Therefore, Applicants respectfully submit that the cited combination of Ludwig et al. in view of Wilska et al. does not teach, disclose, or suggest all of the elements of claim 17 as combined therein.

As to the second reason cited above, the Office Action correctly acknowledges that Ludwig et al. "does not disclose a radio enable handheld computer being sized to fit in a pocket." However, the Office Action further states that "Wilska et al. teaches a cellular mobile notebook computer (fig. 7, fig. 8, and fig. 9) that fits in a users pocket (paragraph 0037 lines 1-8)." Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine the laptop videoconferencing system of Ludwig et al. with the notebook computer of Wilska et al. for at least the reason that such modification would render the laptop videoconferencing system of Ludwig et al. unsuitable for its intended purpose and principal goal to "replicate in a desktop environment, to the maximum extent possible, the full range, level, and intensity of interpersonal communication and information sharing ... ." Col. 1, lines 19-22. Viewed as a whole, the laptop taught by Ludwig et al. "tightly integrates a carefully selected set of multimedia and collaborative capabilities, principal among which are desktop teleconferencing and multimedia mail. Col. 3, lines 3-6. In contrast, the notebook computer of Wilska et al. has limited capabilities and includes a much smaller display such that it is not suited for maximizing videoconferencing in a desktop environment. As such, one of ordinary skill in the art would not have been motivated to combine the laptop videoconferencing system of Ludwig et al. with the notebook computer of Wilska et al. to somehow arrive at the subject matter of claim 17.

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Thus, the combined teachings of Ludwig et al. and Wilska et al. are not sufficient to render the subject matter of claim 17 *prima facie* obvious because the cited combination fails to teach, disclose, or suggest all of the elements of claim 17 as combined therein, and because there is no suggestion or motivation to modify Ludwig et al. or to otherwise combine the teachings of Ludwig et al. and Wilska et al. to arrive at the subject matter of claim 17. Any suggestion or motivation to combine or otherwise modify the teachings of Ludwig et al. and Wilska et al. has been taken from Applicants' own disclosure using hindsight, which is improper. Accordingly, Applicants request that the rejection of claim 17 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 18-22 depend from claim 17 and are thus patentable over the cited combination of references for at least the same reasons, and Applicants further request that the rejection of claims 18-22 under 35 U.S.C. § 103(a) be withdrawn as well.

Applicants further submit that claim 21, which depends from claim 17, is patentable over the cited combination of Ludwig et al. and Wilska et al. for the additional reason that the cited combination of references does not teach, disclose, or suggest "a user selectable option configured to effectuate swapping of the first indicator from the first display screen portion to the second display screen portion and the second indicator from the second display screen portion to the first display screen portion" as included in the combination of elements of claim 21. The Office Action suggests that this element is taught as the "hangup, hold closeby and adjourn icon" in Ludwig et al. Applicants respectfully disagree. These icons are not disclosed in Ludwig et al. as enabling any sort of swapping of indicators. For example, the "hold" icon cited by the Office Action is taught by Ludwig et al. as merely indicating in a hold indicating area that a particular call has been placed on hold. Ludwig et al. does not disclose that images of call participants (or any other indicator) are removed from the mosaic area to the calls on hold indicating area and are replaced with an image of another call participant (or any other indicator) that is removed from the calls on hold indicating area. Therefore, Applicants respectfully submit that the cited combination of Ludwig et al. in view of Wilska et al. does not teach, disclose, or suggest all of the elements of claim 21 as combined therein for at least this additional reason, and respectfully request withdrawal of the rejection of claim 21 under 35 U.S.C. § 103(a).

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**b. Rejection of claims 1-3 and 5-16 based Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al.**

In section 3 of the Office Action, claims 1-3 and 5-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vainio et al. (U.S. Patent No. 6,577,721) in view of Roustaei et al. (U.S. Published Patent Application No. 2001/0034222) and further in view of Ludwig et al.

**i. Claims 1-3 and 5-9**

Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 1 for at least two reasons. First, the cited combination of Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. fails to teach, disclose, or suggest all of the elements of claim 1 as combined therein. Second, there is no suggestion or motivation to modify Vainio et al. or to otherwise combine the teachings of Vainio et al. with Roustaei et al. and Ludwig et al. to arrive at the subject matter of claim 1.

As to the first reason cited above, claim 1 recites “the user interface including a hold area of the display configured to display indicators representative of the parties on hold and an active area of the display configured to display indicators representative of the parties active on the conference call.” The cited combination of Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. does not teach, disclose, or suggest “the user interface including a hold area of the display configured to display indicators representative of the parties on hold and an active area of the display configured to display indicators representative of the parties active on the conference call” as included in the combination of elements of claim 1.

The Office Action correctly acknowledges that Vainio et al. “do not disclose the user interface including a hold area of the display configured to display indicators representative of the parties on hold and an active area of the display configured to display indicators representative of the parties active on the call.” However, the Office Action further states that Ludwig et al. “teaches a laptop computer which operates through a cellular link (col. 14 line 64 through col. 15 line 11) where the user interface (fig. 8b) including a hold area of the display

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configured to display indicators representative of the parties on hold and an active area of the display configured to display indicators representative of the parties on the conference call (col. 24, lines 23-36, fig. 8B and col. 24 lines 22-36, fig. 35 and col. 36 line 14 through col. 38 line 55).” Applicants disagree that what is taught in Ludwig et al. is a hold area of the display and an active area of the display (i.e., two different and distinct screen portions). What is shown in Ludwig et al. is an image (mosaic) area of the screen and a hold indicating area. Nothing in Ludwig et al. indicates that the mosaic displays are an active area of the display screen, or that when call participants shown in the mosaic area of the screen are put on hold that their image is removed from the mosaic area. Therefore, it is not necessarily an active area of the screen as participants may be either on hold or active while their image is in the mosaic area. The indicator on the calls on hold area of the screen would indicate which of the participants are on hold. Therefore, Applicants respectfully submit that the cited combination of Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. does not teach, disclose, or suggest all of the elements of claim 1 as combined therein.

As to the second reason cited above, applicants further submit that one of ordinary skill in the art would not have been motivated to combine the radio telephone of Vainio et al. with the laptop video conferencing system of Ludwig et al. for at least the reason that Vainio et al. teaches away from Ludwig et al. Vainio et al. teaches a radio telephone 1 having control means 11 configured to automatically join all parties to a conference call with minimal user input, where the required caller information for each party is loaded in advance of the conference call. Vainio et al. further teaches that the typical manual process for setting up a conference call wherein a user manually places callers on hold using a menu selection and manually inputs codes to join other callers “can be difficult and time consuming to perform” and “increases the chance of a mistake which can result in, for example, lost connections and/or wrong numbers being dialed.” See col. 1, lines 12-64. In fact, Vainio et al. makes no mention of a user interface having a hold area and an active area such that a user can manually manage conference calls during the call. In contrast, the laptop video conferencing system taught by Ludwig et al. is configured to allow the user to have full control over joining callers to a conference call and managing the individual

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callers of a conference call. As such, one of ordinary skill in the art would not have been motivated to combine the radio telephone of Vainio et al. with the laptop videoconferencing system of Ludwig et al. to somehow arrive at the subject matter of claim 1.

Thus, the combined teachings of Vainio et al., Roustaei et al., and Ludwig et al. are not sufficient to render the subject matter of claim 1 *prima facie* obvious because the cited combination fails to teach, disclose, or suggest all of the elements of claim 1 as combined therein, and because there is no suggestion or motivation to modify Vainio et al. or to otherwise combine the teachings of Vainio et al., Roustaei et al., and Wilska et al. to arrive at the subject matter of claim 1. Any suggestion or motivation to combine or otherwise modify the teachings of Vainio et al., Roustaei et al., and Wilska et al. has been taken from Applicants' own disclosure using hindsight, which is improper. Accordingly, Applicants request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 2-3 and 5-9 depend from claim 1 and are thus patentable over the cited combination of references for at least the same reasons, and Applicants further request that the rejection of claims 2-3 and 5-9 under 35 U.S.C. § 103(a) be withdrawn as well.

ii. **Claims 10-16**

Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 10 for at least two reasons. First, the cited combination of Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. fails to teach, disclose, or suggest all of the steps of claim 10 as combined therein. Second, there is no suggestion or motivation to modify Vainio et al. or to otherwise combine the teachings of Vainio et al. with Roustaei et al. and Ludwig et al. to arrive at the subject matter of claim 10.

As to the first reason cited above, claim 10 recites "placing the first call on hold at the request of a user and placing an indicator representative of the first call in a hold section of the display and removing the indicator representative of the first call from an active section of the display." The cited combination of Vainio et al. in view of Roustaei et al. and further in view of

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Ludwig et al. does not teach, disclose, or suggest “placing the first call on hold at the request of a user and placing an indicator representative of the first call in a hold section of the display and removing the indicator representative of the first call from an active section of the display” as included in the combination of steps of claim 10.

The Office Action correctly acknowledges that Vainio et al. “does not disclose placing an indicator representative of the second call in an active section of the display and removing the indicator representative of the first call from an active section of the display.” However, the Office Action further states that Ludwig et al. “teaches a laptop computer which operates through a cellular link (col. 14 line 64 through col. 15 line 11) where the user interface (fig. 8b) including a hold area of the display configured to display indicators representative of the parties on hold and an active area of the display configured to display indicators representative of the parties on the conference call (col. 24, lines 23-36, fig. 8B and col. 24 lines 22-36, fig. 35 and col. 36 line 14 through col. 38 line 55).” Applicants disagree that what is taught in Ludwig et al. is a hold section of the display and an active section of the display (i.e., two different and distinct screen portions). What is shown in Ludwig et al. is an image (mosaic) area of the screen and a hold indicating area. Nothing in Ludwig et al. indicates that the mosaic displays are an active section of the display screen, or that when call participants shown in the mosaic area of the screen are put on hold that their image is removed from the mosaic area. Therefore, it is not necessarily an active section of the screen as participants may be either on hold or active while their image is in the mosaic area. The indicator on the calls on hold area of the screen would indicate which of the participants are on hold. Therefore, Applicants respectfully submit that the cited combination of Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. does not teach, disclose, or suggest all of the steps of claim 10 as combined therein.

As to the second reason cited above, applicants further submit that one of ordinary skill in the art would not have been motivated to combine the radio telephone of Vainio et al. with the laptop video conferencing system of Ludwig et al. for at least the reason that Vainio et al. teaches away from Ludwig et al. Vainio et al. teaches a radio telephone 1 having control means 11

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configured to automatically join all parties to a conference call with minimal user input, where the required caller information for each party is loaded in advance of the conference call. Vainio et al. further teaches that the typical manual process for setting up a conference call wherein a user manually places callers on hold using a menu selection and manually inputs codes to join other callers “can be difficult and time consuming to perform” and “increases the chance of a mistake which can result in, for example, lost connections and/or wrong numbers being dialed.” See col. 1, lines 12-64. In fact, Vainio et al. makes no mention of a user interface having a hold section and an active section such that a user can manually manage conference calls during the call. In contrast, the laptop video conferencing system taught by Ludwig et al. is configured to allow the user to have full control over joining callers to a conference call and managing the individual callers of a conference call. As such, one of ordinary skill in the art would not have been motivated to combine the radio telephone of Vainio et al. with the laptop videoconferencing system of Ludwig et al. to somehow arrive at the subject matter of claim 10.

Thus, the combined teachings of Vainio et al., Roustaei et al., and Ludwig et al. are not sufficient to render the subject matter of claim 10 *prima facie* obvious because the cited combination fails to teach, disclose, or suggest all of the steps of claim 10 as combined therein, and because there is no suggestion or motivation to modify Vainio et al. or to otherwise combine the teachings of Vainio et al., Roustaei et al., and Wilska et al. to arrive at the subject matter of claim 10. Any suggestion or motivation to combine or otherwise modify the teachings of Vainio et al., Roustaei et al., and Wilska et al. has been taken from Applicants’ own disclosure using hindsight, which is improper. Accordingly, Applicants request that the rejection of claim 10 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 11-16 depend from claim 10 and are thus patentable over the cited combination of references for at least the same reasons, and Applicants further request that the rejection of claims 11-16 under 35 U.S.C. § 103(a) be withdrawn as well.

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**c. Rejection of claim 4 based Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. and further in view of Pelletier**

In section 5 of the Office Action, claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. and further in view of Pelletier (U.S. Published Patent Application No. 2004/0028192). Claim 4 depends from claim 1. As stated above, the subject matter of claim 1 is not taught, disclosed, or suggested by any proper combination of Vainio et al., Roustaei et al. and Ludwig et al. As to Pelletier, it fails to make up for any of the above-mentioned deficiencies in the combination of Vainio et al., Roustaei et al. and Ludwig et al. with regard to claim 1. Thus, claim 4 is patentable over the cited combination of Vainio et al. in view of Roustaei et al. and further in view of Ludwig et al. and further in view of Pelletier for at least the same reasons as claim 1. Accordingly, Applicants request that the rejection of claim 4 under 35 U.S.C. § 103(a) be withdrawn.

**Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

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If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 10/24/2005

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